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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,812	03/30/2001	David W. Cannell	05725.0783-00	5365
22852	7590	08/11/2005		
			EXAMINER	
			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/820,812	CANNELL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Shengjun Wang	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 25 May 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-100 is/are pending in the application.  
4a) Of the above claim(s) 7-16, 18, 20, 21, 34-42, 55-64, 66-69 and 82-90 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-6, 17, 19, 22-33, 43-54, 65, 70-81 and 91-100 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 27, 2005 has been entered.

### *Double Patenting Rejections*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, 91-100 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 44-146 of U.S. Patent No. 6,486,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims herein are generic to the claims presented in '105.

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4. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, 91-100 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-112 of U.S. Patent No. 6,800,302. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims herein and the claims in '302 have essentially the same steps, but differ in intended functions, i.e., protecting keratinous fiber (hair) herein vs. shaping the keratinous fiber in '302. The method in '302 would read on the instant method as practicing the method of '302 would inherently practice the method herein claimed (protecting the keratinous fiber).

5. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, 91-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 57-85, 88-115, 117-135 and 138-165 of copending Application No. 09/820856. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims herein and the claims in '302 have essentially the same steps, but differ in intended functions, i.e., protecting keratinous fiber (hair) herein vs. shaping the keratinous fiber in '856. The method in '856 would read on the instant method as practicing the method of '856 would inherently practice the method herein claimed (protecting the keratinous fiber).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, 91-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60-186 of copending Application No. 09/820,934. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are

generic to the claims in '934. Particularly, the claims herein is generic as to other ingredients presented in the composition employed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to the Arguments***

Applicants' amendments and remarks submitted April 27, 2005 have been fully considered, and found persuasive to overcome the rejections under 35 U.S.C. 103 over Karlen et al. and Bertho et al. Particularly, claims as amended, require the heating step be next in time, space or order of the application of the composition. As argued by applicants' the cited references do not teach a fairly suggest the method as herein claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*SHENGJUN WANG*  
**PRIMARY EXAMINER**  
Shengjun Wang  
Primary Examiner  
Art Unit 1617